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EXAMINER

DIVECHA, KAMAL B

ART UNIT PAPER NUMBER

2151

DATE MAILED: 01/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/993,906

Applicant(s)

COWDEN ET AL.

Examiner

KAMAL B. DIVECHA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

Claims 1-9 are pending in this application.

Claim Rejections - 35 USC § 112

The 35 USC 112, second paragraph rejection presented in the final office action have been withdrawn.

Applicant's arguments filed September 23, 2005 have been fully considered, as per request for continued examination (RCE) filed on November 15, 2005, but they are not persuasive.

The examiner summarizes the applicant's arguments presented in the response filed on September 23, 2005 and addresses each argument individually.

As per applicants arguments filed on September 23, 2005, the applicant argues in substance that:

- a. InfoWorld does not disclose a process of using a computer program to detect a need for the computer program in the computer (remarks, pg. 5).

In response to [a.]: Examiner agrees that InfoWorld does not disclose a process of using a computer program to detect a need for the computer program in the computer (see detailed action below) and presents Humes to disclose the recited limitation set herein.

- b. Humes' computer program is not employed to detect a need for a computer program (remarks, pg. 5).

In response to [b.]: Examiner respectfully disagrees.

As per applicant, the act of using the computer program to detect a need for the computer program in the computer includes detecting the occurrence of a type of window (applicant claim

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2, i.e. it suggests that detecting a need for computer program in the computer is achieved by detecting the occurrence of a type of window).

Based on the above teaching, it is respectfully submitted that Humes explicitly detects a need for a computer program by detecting and blocking the occurrence of web pages (i.e. occurrence of type of windows, Humes, col. 4 L51-57, col. 5 L3-14).

Technically, if the filtering program of Humes were made available in a demo version as disclosed by InfoWorld (InfoWold, pg. 1 para. 3), the demo filtering program would have detected the occurrence of type of web pages (i.e. windows) and block them accordingly or based on some criteria or rules list, which would have detected and indicated to the user, a need for the filtering program in the computer, by simply detecting and blocking the occurrence of a type of web pages (i.e. windows) and further displaying the forbidden page to the user with the score that indicates to the user the number of pages filtered and blocked.

As is also known in the art, both technically and inherently, Demo software's usually detects and/or demonstrates the usefulness, advantages and the need of the software to the user in a client computer. Therefore in any event even if InfoWorld and Humes fails to disclose (which they don't) such a limitations, it should have been understood that demo software's provided to the user demonstrates to the user the advantages and the need for full version of the similar software i.e. using the computer program (demo version) to detect a need for the computer program (full version) in the computer.

c. InfoWorld does not provide details on how the demo software is offered to potential users i.e. InfoWorld does not disclose the teaching "offering the computer program to the user **after installation** of the computer program in the computer and

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providing the computer program to the computer if the user accepts the offer” according to applicant (remarks, pg. 5).

In response to [c.]: Examiner respectfully disagrees and would like to point out the same defect in the claim, i.e. claim 1 does not provide any details on how the software is offered to the user.

InfoWorld states: “**after a demo application’s trial period ends**, SalesAgent acts as a built-in salesperson and walks the user through a **simple sales** and registration process that includes the option to pay online using the Internet or a modem, or off-line using the phone, fax or email. SalesAgent allows users to instantly turn their “demo” into a full, purchased product” (InfoWorld, page 1 para. 1).

In the aforementioned paragraph, it is obvious that the demo application (computer program) was installed and running during the trial period and after a demo application’s trial period ends, a full version of the application is offered to the user by a built-in salesperson who walks the user through a **simple sales** and registration process.

Therefore, for the at least reasons set forth above, Claim 1 is not patentable over InfoWorld and Humes.

d. The applicant disagreed with the conclusion that a web page can be interpreted as a type of window and argues that a window in the context of computers is notoriously well understood term (remarks, pg. 6 para. 1).

In response to [d.]: Examiner would like to point the applicant to applicant’s specification that states: “In the present disclosure, **the term “window” is used to refer to any mechanism for presenting information to a user.** Thus, the term “window” also includes message boxes,

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dialog boxes, text boxes, banners, etc. A window may be associated with a web browser, or may be generated as a result of receiving information from another computer over a computer network (applicant specification, page 5 line 19 to page 6 line 1)".

Therefore, based on the above definitions, it is clearly understood that anything that presents information to a user could be interpreted as a window.

As such, examiner has interpreted the content, pages, web pages and web sites of Humes as one aspect of the term "window" as defined by the applicant (hereinafter content, pages, web pages or web sites).

e. Humes does not disclose or suggest informing the user of the number of a type of window detected by the computer program and further argues that "even in the improper construction that content is a window, Humes does not disclose or suggest informing the user of the number of "web pages" that have been filtered (remarks, pg. 6 para. 2).

In response to [e.]: Examiner has already shown above the proper construction and/or the similarities between the term window and content, pages, web pages, web sites, etc., based on applicant's specification (see reasons set forth in d).

Further Humes explicitly teaches the process of informing the user a number of a type of window detected by the computer program (Humes, col. 5 L6-14, col. 6 L5-16 and col. 7 L55-65: the forbidden page is displayed to the user with the total score i.e. the number of detected and blocked or filtered pages when a url, window, web page, content, web site is filtered).

f. Humes does not disclose or suggest a window blocking computer program (remarks, pg. 6 para. 3).

In response to [f.]: Examiner has already shown above the interpretation of the term “window” in the context of computers, based on the applicants specification.

Therefore, based on the applicant’s specification (i.e. definition of the term “window”), it’s clearly understood that Humes does disclose the window blocking computer program (i.e. content filtering computer program, i.e. window blocking computer program, see abstract, fig. 2, col. 4 L51-58).

g. Teng does not disclose the process of downloading components of the computer program from a remote computer (remarks, pg. 7 para. 1).

In response to [g.]: Applicant's arguments with respect to claim 5 have been considered but are moot in view of the new ground(s) of rejection (please see the detailed action).

Therefore, for the at least reasons set forth above, the rejection is maintained with respect to claims 1-4 and 6-9.

DETAILED ACTION

Specification

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and use the invention, i.e., failing to provide an enabling disclosure.

The test to be applied under the written description portion of 35 U.S.C. § 112, first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of later claimed subject matter. Vas-Cat, Inc. v. Mahurkar, 935 F. 2d 1555, 1565, 19 USPQ2d 111, 1118 (Fed. Cir. 1991), reh'rg denied (Fed. Cir. July 8, 1991) and reh'rg, en banc, denied (Fed. Cir. July 29, 1991).

The applicants have failed to provide an enabling disclosure in the detailed description of the embodiment. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to support the subject matter set forth in these claims.

The claims recite the limitation of “installing a computer program in the computer, the computer program being partially disabled as installed” and “using the computer program to detect a need for the computer program in the computer (remarks page 2 claim 1 and claim 7)”. However, the specification merely describes the process wherein the computer program is installed but remains partially disabled (i.e. inactive) until the user accepts it (specification, page 30 lines 1-2) and the process wherein the user’s need for the computer program is detected (specification, page 30 line 5, fig. 10 item #1004) and further applicant does not disclose or suggest how the user’s need for the computer program is detected, neither in specification nor in the drawings (see fig. 10). Hence, the above claimed limitation was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1-9 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-4 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over InfoWorld Publishing Co. (hereinafter InfoWorld, "Release Software and Demo 97 Demoletter to Provide Real Demos online", pp. 1-2, February 5, 1997) in view of Humes (U. S. Patent No. 5,996,011).

As per claim 1, InfoWorld discloses a method to be performed in a computer, the method comprising: installing a computer program (read as a demo or trial version of the software) in the computer, the computer program being partially disabled as installed; informing a user of usefulness of the computer program; offering the computer program to the user after installing of the computer program in the computer and providing the computer program to the user if the user accepts the offer (pg. 1 paragraph #3), however InfoWorld does not explicitly

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disclose a process of using the computer program to detect a need for the computer program in the computer.

Humes, from the same field of endeavor discloses a computer program for filtering or blocking the certain types of websites or web pages (that is this computer program determines and detects a need for computer program in the computer by detecting the occurrence of a type of web page and filtering those web pages, based on the applicant claim 3, see abstract, fig. 3, col. 2 L31 to col. 3 L22, col. 4 L10-20). Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify InfoWorld in view of Humes, in order to detect a need for the computer program in the computer by using the computer program because Humes teaches the process of detecting the occurrence and filtering the windows or web pages. One of ordinary skilled in the art would have been motivated because it would provided the users the ability to try before they buy the software over the Internet.

As per claim 2, InfoWorld does not explicitly disclose the process wherein the software includes detecting the occurrence of a type of window. Humes discloses the process wherein the computer program detects the occurrence of the certain type of websites or web pages (read website or web page as a type of window, see abstract, fig. 3, col. 2 L31 to col. 3 L22, col. 4 L10-20). Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to incorporate the teaching of Humes with InfoWorld in order to the process of using the computer program to detect a need for the computer program in the computer by detecting the occurrence of a type of window. One of ordinary skilled in the art would have been motivated because it would have showed user the usefulness of the computer

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program by simply demonstrating the functions of detecting the occurrence of type of window by the computer program.

As per claim 3, InfoWorld does not explicitly disclose the process of informing the user a number of a type of window detected by the computer program. Humes discloses the process of displaying the forbidden page to the user when the web page is filtered wherein the forbidden page includes or provides information such as the total score for the page and wherein a score is the variable which keeps track of the total score of the URL being detected and filtered (fig. 3, col. 2 L31 to col. 3 L22, col. 4 L10-20, col. 6 L7-16 and col. 7 L60-65). Therefore it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to incorporate the teaching of Humes with InfoWorld in order to inform a user a number of type of window detected by the computer program. One of ordinary skilled in the art would have been motivated because it would have employed a mechanism for tracking the total score (i.e. the number) of the filtered windows (Humes, col. 6 L15-17).

As per claim 4, InfoWorld discloses the process of activating the full version of computer program after the demo or trial version expires and user purchases the software (pg. 1 paragraph #3).

As per claim 6, InfoWorld does not explicitly disclose the process wherein the computer program includes a window-blocking computer program. Humes discloses a window-blocking computer program (col. 2 L31 to col. 3 L22, col. 4 L10-20). Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify InfoWorld in order to distribute the window-blocking compute program, in view of Humes since Humes discloses the window-blocking computer program. One of ordinary skilled in the art

would have been motivated because it would have output to the client computer only those web pages, which are deemed appropriate for viewing by the user of the client computer and block or filter others that are not deemed appropriate (Humes, col. 4 L51-58).

As per claims 7-9, they do not teach or further define over the limitation in claims 1-4 and 6. Therefore, claims 7-9 are rejected for the same reasons as set forth in claims 1-4 and 6.

3. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over InfoWorld Publishing Co. (hereinafter InfoWorld, "Release Software and Demo 97 Demoletter to Provide Real Demos online", pp. 1-2, February 5, 1997) in view of Humes (U. S. Patent No. 5,996,011), and further in view of Cinecom corporation (hereinafter Cinecom, document #1043564).

As per claim 5, InfoWorld in view of Humes discloses a remote computer (Humes, col. 1 L41-51), however InfoWorld in view of Humes does not disclose the process wherein the act of providing the computer program to a user includes downloading components of the computer program from a remote computer. Cinecom discloses the process of downloading trial and demo software to purchase full, registered versions by downloading complete versions of the application (Cinecom, pg. 1 paragraph 3). Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify InfoWorld in view of Humes and further in view of Cinecom, in order to download the components of the compute program from a remote computer, since Cinecom teaches the process of downloading trial or demo versions and downloading the complete versions of the software. One of ordinary skilled in the art would have been motivated so that the complete versions of the software would have been provided to the users (Cinecom, pg. 1 paragraph 3).

Additional References

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see also PTO-892 mailed on 03/25/2005).


- a. NPL, Software Corporation Receives Financial backing for embedded sales Agent Technology, pp. 1-2, March 4, 1996, document #0920661.
- b. NPL, Panicware, Inc. Announces Pop-up Stopper 2.2, a free utility, pg. 1.
- c. NPL, Panicware, Inc. Announces Don't Panic! Version 1.2, pg. 1.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KAMAL B. DIVECHA whose telephone number is 571-272-5863. The examiner can normally be reached on Increased Flex Work Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on 571-272-3939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kamal Divecha
Art unit 2151
January 12, 2006.


ZARNI MAUNG
SUPERVISORY PATENT EXAMINER